

REMARKS

Applicant has carefully reviewed the Application in light of the Office Action mailed December 15, 2004. At the time of the Office Action, Claims 1-20 were pending in the Application. Applicant amends Claims 1, 9, 12, and 17 and cancels Claim 14 without prejudice or disclaimer. The amendments and cancellations to these claims are not the result of any prior art reference and, thus, do not narrow the scope of any of the claims. Furthermore, the amendments are not related to patentability issues and only further clarify subject matter already present. All of Applicant's amendments have only been done in order to advance prosecution in this case. Applicant respectfully requests reconsideration of the pending claims and favorable action in this case.

Consideration of Information Disclosure Statement

Applicant submits an Information Disclosure Statement (IDS) with this Response. Applicant respectfully requests the Examiner to review this IDS and to formally indicate that these materials have been considered in the context of the pending prosecution. Applicant suggests the Examiner use a PTO-1449 to provide written notification to this effect.

Section 102 Rejection

The Examiner rejects Claims 1-10, 12-13, and 15-19 under 35 U.S.C. §102(e) as being anticipated by U.S. Patent No. 6,480,483 issued to Yahata (hereinafter "*Yahata*"). This rejection is respectfully traversed for the following reasons.

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Independent Claim 1, as amended, recites:

1. A method for synchronizing clock dividers in a wireless network, comprising:
grouping a first plurality of wireless base stations into a first cluster;
grouping a second plurality of base stations into a second cluster;
transmitting a synchronization pulse to each of the first plurality of wireless base stations in the first cluster, wherein at least a first wireless base station in the first cluster has a wireless communication link to a first wireless base station in the second cluster, wherein the first wireless base station in the first and second clusters each include a local clock unit having an internal clock divider that is operable to derive frame and burst clocks from a received master clock signal;
wherein the first wireless base station in the first cluster is operable to transmit a synchronization pulse to other wireless base stations in the first cluster and to the first wireless base station in the second cluster;

wherein the first wireless base station in the second cluster is operable to transmit the synchronization pulse to other wireless base stations in the second cluster;

transmitting the synchronization pulse to the second plurality of wireless base stations in the second cluster;

resetting the internal clock dividers in each wireless base station in response to the synchronization pulse in order to achieve a level of synchronization separate from synchronization provided by the master clock signal.

Applicant respectfully reminds the Examiner that a claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.¹ In addition, "[t]he identical invention must be shown in as complete detail as is contained in the . . . claims" and "[t]he elements must be arranged as required by the claim."² In regard to inherency of a reference, "[t]he fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic."³ Thus, in relying upon the theory of inherency, an Examiner must provide a basis in fact and/or technical reasoning to support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art.⁴

Using the preceding well-settled jurisprudence, it is clear that *Yahata* fails to anticipate Independent Claim 1. For example, *Yahata* fails to teach, suggest, or disclose a first wireless base station in the first and second clusters each including a local clock unit having an internal clock divider that is operable to derive frame and burst clocks from a received master clock signal, and resetting the internal clock dividers in each wireless base station in response to the synchronization pulse in order to achieve a level of synchronization separate from synchronization provided by the master clock signal, as is recited in Independent Claim 1.

In contrast, *Yahata* discloses a frame synchronization system between base stations of a mobile radio communication system and a base station device employing this system. (See Abstract of *Yahata*). However, missing from *Yahata* is any disclosure that is relevant to a

¹ *Verdegaal Bros. v. Union Oil Co. of California*, 2 USPQ 2d 1051, 1053 (Fed. Cir. 1987); MPEP §2131.

² *Richardson v. Suzuki Motor Co.*, 9 USPQ 2d 1913, 1920 (Fed. Cir. 1989); *In re Bond*, 15 USPQ 2d 1566 (Fed. Cir. 1990); MPEP §2131 (*emphasis added*).

³ MPEP §2112 (citing *In re Rijckaert*, 9 F.3d 1531, 1534, 28 USPQ 2d 1955, 1957 (Fed. Cir. 1993) (*emphasis in original*)).

⁴ MPEP §2112 (citing *Ex Parte Levy*, 17 USPQ 2d 1461, 1464 (Bd. Pat. at App. and Inter. 1990) (*emphasis in original*)).

first wireless base station in the first and second clusters each including a local clock unit having an internal clock divider that is operable to derive frame and burst clocks from a received master clock signal and resetting the internal clock dividers in each wireless base station in response to the synchronization pulse in order to achieve a level of synchronization separate from synchronization provided by the master clock signal. This is because the architecture of *Yahata* operates in a different manner and, thus, does not provide multiple layers of synchronization. Moreover, the system of *Yahata* fails to account for frame and burst clocks from a received master signal. Both of these properties are included in Independent Claim 1. The “relevant” passages cited by the Examiner in the Office Action fail to offer any substantive information that would support any §102 rejection addressing the pending subject matter. No disclosure is provided to address these limitation, which are identified supra.

Accordingly, Independent Claim 1 is clearly patentable over *Yahata* for at least this reason. Additionally, Independent Claims 9, 12, and 17 recite a similar (but not an identical) limitation and, therefore, are also allowable over *Yahata*. In addition, their corresponding dependent claims are patentable over *Yahata* for analogous reasons. Notice to this effect is respectfully requested.

Section 103 Rejection

The Examiner rejects Claims 11, 14, and 20 under 35 U.S.C. §103(a) as being unpatentable over *Yahata*. This rejection is respectfully traversed for the following reasons.

Applicant respectfully reminds the Examiner that to establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation; either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Third, the prior reference (or references when combined) must teach or suggest all of the claim limitations.⁵ It is respectfully submitted that these rejected Claims are patentable over the art of record based on at least the third criterion of obviousness: none of the references alone or in combination teach, suggest, or disclose each and every claim limitation.

⁵ See M.P.E.P. §2142-43.

The Independent Claims have been shown to be allowable in the §102 analysis above, as they are easily distinguishable over *Yahata*. Furthermore, there is nothing that is combinable with *Yahata* that could inhibit the patentability of the pending claims. Thus, the Examiner has failed to satisfy each of the elements of non-obviousness, which are required to support a proper §103 analysis according to M.P.E.P. §2143.

However, for purposes of redundancy and to unquestionably demonstrate the allowability of the pending claims, Applicant proffers this additional analysis for the convenience of the Examiner. As an initial matter, Applicant wishes to note that even if these elements of Independent Claim 1 were disclosed in cited references, which they are not, the proposed *Yahata* combinations are still improper because the Examiner has not shown the required suggestion or motivation in *Yahata*, or in the knowledge generally available to one of ordinary skill in the art at the time of the invention to combine these references. The mere fact that references *can* be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination.⁶ Thus, the mere fact that the teachings of one reference would improve the teachings of another reference, as the Examiner asserts, does not provide the required suggestion to combine. The U.S. Court of Appeals for the Federal Circuit has held that the fact that the prior art may be modified does not make the modification obvious unless the prior art suggests the desirability of the modification.⁷

⁶ M.P.E.P. §2143.01 (emphasis in original).

⁷ *In re Fritch*, 972 F.2d 1260, 1266 (Fed. Cir. 1992).

Nothing in *Yahata* suggests or motivates the proposed synchronization operations, nor has the Examiner provided evidence that suggests or motivates the proposed combination.⁸ Speculation in hindsight that “it would have been obvious” to make the proposed combination because the proposed combination would be helpful is insufficient under M.P.E.P.⁹ guidelines and governing Federal Circuit case law.¹⁰ The M.P.E.P. consistently confirms that this approach is improper and, thus, it should not be used here.¹¹

Therefore, all of the pending claims have been shown to be allowable over the references of record. Notice to this effect is respectfully requested in the form of a full allowance of the pending claims.

⁸ If “common knowledge” or “well known” art is being relied on to combine the references, Applicant respectfully request that a reference be provided in support of this position pursuant to M.P.E.P. §2144.03. If personal knowledge is being relied on to supply the required motivation or suggestion to combine, Applicant respectfully requests that an affidavit supporting such facts be provided pursuant to M.P.E.P. §2144.03.

⁹ See M.P.E.P. §2145 X.C. (“The Federal Circuit has produced a number of decisions overturning obviousness rejections due to a lack of suggestion in the prior art of the desirability of combining references.”).

¹⁰ For example, in *In re Dembiczak*, 175 F.3d 994 (Fed. Cir. 1999), the Federal Circuit reversed a finding of obviousness by the Board of Patent Appeals and Interferences, explaining that evidence of a suggestion, teaching, or motivation to combine is essential to avoid impermissible hindsight reconstruction of an applicant’s invention:

Our case law makes clear that the best defense against the subtle but powerful attraction of hindsight obviousness analysis is *rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references*. Combining prior art references without evidence of such a suggestion, teaching, or motivation simply takes the inventor’s disclosure as a blueprint for piecing together the prior art to defeat patentability—the essence of hindsight.

175 F.3d at 999 (quoting *W.L. Gore & Assoc., Inv. v. Garlock, Inc.*, 721 F.2d 1540, 1553 (Fed. Cir. 1983)) (emphasis added) (citations omitted). See also *In Re Jones*, 958 F.2d 347 (“Conspicuously missing from this record is any evidence, other than the PTO’s speculation (if that can be called evidence) that one of ordinary skill in the herbicidal art would have been motivated to make the modification of the prior art salts necessary to arrive at [the claimed invention].”).

¹¹ See M.P.E.P. §2145.

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CONCLUSION

Applicant has now made an earnest attempt to place this case in condition for immediate allowance. For the foregoing reasons and for all other reasons clear and apparent, Applicant respectfully requests reconsideration and allowance of the pending claims.

Applicant submits herewith a check in the amount of \$180.00 to cover the cost of the IDS filing fee. However, if this is not the case, the Commissioner is hereby authorized to charge any amount required or credit any overpayment to Deposit Account No. 02-0384 of BAKER BOTTS L.L.P.

If there are matters that can be discussed by telephone to advance prosecution of this application, Applicant invites the Examiner to contact Thomas Frame at 214.953.6675.

Respectfully submitted,
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